

IN THE U.S. PATENT AND TRADEMARK OFFICE

Appellants: James A JOHANSON et al.
Application No.: 09/777,884
Art Unit: 2452
Filed: February 7, 2001
Examiner: Dohm Chankong
For: BLUETOOTH DEVICE POSITION DISPLAY
Attorney Docket No.: 129250-001020/US

APPELLANTS' REPLY BRIEF ON APPEAL

MAIL STOP APPEAL BRIEF - PATENTS

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

March 22, 2011

ARGUMENTS:

A. The Section 112 Rejections

In their opening brief the Appellants took the position that claims 19 and 32 satisfied 35 U.S.C. §112, first paragraph, because the phrase "that are not grouped" has sufficient basis in the original disclosure. In the Examiner's Answer the Examiner disagrees.

Rather than address statements in the Answer that the Examiner has raised before, the Appellants will address just those statements that appear to be newly introduced by the Examiner.

The Examiner takes the position that because the specification states that a "device communicates with all nearby electronic devices" and "nearby" is determined by a Bluetooth signal that "Appellant's invention therefore *requires* (emphasis from Answer) grouping devices by proximity...". Appellants disagree.

It is clear from this section of the specification that the purpose of communicating with nearby devices is to identify their individual locations. No grouping occurs due to such communications or identifications. The specification excerpt relied on by the Examiner (page 4, lines 14-16) goes on to state that "the first electronic device 10 then displays where each other electronic device is in relation to the first electronic device 10 so the user can select **an** electronic device to communicate with." (emphasis added)(see lines 16-18). Thus, instead of communicating with a group of devices, each electronic device is communicated with individually. Contrary to the Examiner's argument, there is no rhyme or reason for the nearby devices to be grouped.

The Appellants note that the claims use the phrase "are not grouped" not "group". As used in the claims, "grouped" means an active grouping of devices, or, in the case of the claimed inventions, the lack of such an active grouping.

Compared to the word "group" (which is not in the claims) which is not an action (or a lack of action)".

In sum, Appellants submit that one of ordinary skill in the art upon reading the claims and the specification would indeed conclude that the inventors had possession of the claimed invention, namely, methods and devices for selecting a nearby device, from among a plurality of nearby devices that are not grouped to communicate with, at the time the instant application was filed.

Accordingly, Appellants request withdrawal of the rejections and allowance of claims 19 and 32.

B. The Section 103 Rejections

(i) The combination of Fumarolo, Bork and Tognazzini does not suggest the claimed inventions

In their opening brief the Appellants took the position that Fumarolo discloses the selection of "communication units with the explicit goal of grouping each selected unit into a 'talkgroup'. Said another way, the selection ... relates to the formation of talkgroups, not the selection of a nearby device that has not been grouped associated with a detected signal, as in the claims". The Appellants added that "[r]ather than disclose the selection of a communication unit prior to grouping the unit into a talk group, Fumarolo explicitly discloses selecting one communication unit from a talkgroup to communicate with only after the selected unit has been grouped or re-grouped into a talkgroup".

In response the Examiner argues that "Appellant's claim does not prohibit placing the devices into a group after they have been selected." Such an argument is irrelevant because the claims do not concern themselves with grouping after a nearby device is selected. For sure the claims fail to use many

words, such as "chair" or "table" or "fork" (as well as a long list of other words) but that does not mean that the claims can be interpreted to cover chairs, tables and forks.

Turning to Tognazzini, in their opening brief the Appellants took the position that the phrase "device type" as used in the claims means a type of *communication* device (see paragraph [0019], lines 3 and 4 of the instant specification). In contrast, the type of device disclosed by Tognazzini appears to be a vehicle (i.e., a car).

In the Answer the Examiner again maintains the position that Tognazzini's (and Fumarole's) cars read on a communication device. Appellants disagree.

The Examiner's position strains credulity.

The claimed "nearby devices" are communication or electronic devices that transmit Bluetooth signals. The claims are not directed at vehicles that *contain* communication or electronic devices. Instead, the claims are directed at the devices themselves. Using the Examiner's rationale, all claims directed at communication or electronic devices could be interpreted as cars provided the cars contain a communication or electronic device. Such an interpretation strains credulity.

When properly interpreted the Appellants submit that the subject matter of claims 3, 5, 19, 30-35 and 37 would not have been obvious to one of ordinary skill in the art at the time the instant application was filed based on the combined disclosures of Fumarolo, Bork and Tognazzini.

(ii) The combination of Fumarolo, Bork and Tognazzini is improper

In their opening brief the Appellants took the position that one of ordinary skill in the art would realize that the particular Bluetooth based system in Bork could not be used in the system of Fumarolo or Tognazzini

because such a Bluetooth system would most likely not have the distance or range needed to carry out the principle of operation of Fumarolo or Tognazzini.

Bluetooth systems provide short range communications (see Bork, column 1, lines 44-47) of approximately 100 meters (Bork, column 1, lines 51-52).

In contrast, the principle of operation in Fumarolo requires a signal to travel distances outside the range of a Bluetooth signal, as in the case where communication units belonging to a number of different agencies (i.e. fire department, police department, ambulance) must be grouped together, especially when the individuals operating such units are enroute to an incident (e.g. accident, fire).

The Appellants also recognized that this might be interpreted as being contrary to the Board's earlier decision dated August 24, 2009.

Appellants explained that the claims are directed at specific Bluetooth signals not the generalized "communications in a limited geographic area" referred to previously by the Board. The Appellants noted that it is well known that Bluetooth signals do not propagate over several streets.

In the Answer the Examiner demurs and relies on the Board's earlier decision.

The Appellants further took the position that combining Bork and Tognazzini would also appear to require Tognazzini to impermissible change its principle of operation because the use of a Bluetooth signal in Tognazzini would require Tognazzini to change how it calculates distances (i.e., distances over 100 meters could not be calculated) and would eliminate the usefulness of Tognazzini's alerts (i.e., there is no time for a driver to recognize Tognazzini's alerts).

In response the Examiner argues that the Appellants' focus on Tognazzini is misplaced. Appellants disagree. The claims are directed at the

detection of Bluetooth signals from nearby devices that are not grouped, where each Bluetooth signal contains, among other things, "a device type of the at least one nearby device". As such, the claimed "device type" is a part of a detected Bluetooth signal. Thus, Tognazzini's compatibility, or lack thereof, with Bluetooth signals is highly pertinent. To adopt the Examiner's apparent interpretation (i.e., "device type" is unrelated to Bluetooth signals) would necessarily mean parsing the claims in a way that destroys their meaning; this is impermissible.

Accordingly, the Appellants maintain that the combination of Fumarolo, Bork and Tognazzini is improper for at least the reasons set forth above.

Conclusion:

Appellants respectfully request that members of the Board reverse the decision of the Examiner and allow claims 3, 5, 19, 30-35 and 37.

The Commissioner is authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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